



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,054	06/27/2003	Michael L.F. Chan	TRA-007	7895

3897 7590 12/28/2006

SCHNECK & SCHNECK

P.O. BOX 2-E

SAN JOSE, CA 95109-0005

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 12/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/608,054
Filing Date: June 27, 2003
Appellant(s): CHAN, MICHAEL L.F.

MAILED

DEC 28 2006

Group 3700

Mr. Thomas Schneck
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 8, 2006 appealing from the Office action mailed February 22, 2006

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

This appeal involves claim 19.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 07/25/06 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

Art Unit: 3725

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

1,860,586

McILHenney

05-1932

(9) Grounds of Rejection

Claim 19 is finally rejected under 35 U.S.C. 102(b) as being anticipated by McILHenney.

The device of McILHenny reads on the structural limitation of the claims including an inner box (the combination of 11 and 12) and an outer box (1).

(10) Response to Argument

In response to Appellant's first argument that McILHenney fails to teach an "inner box of rectangular cross section with opposed top and bottom sections", the Examiner has pointed out in the Final Rejection that the inner box of McILHenney consists of the tubular member 12 and the transparent paper 11, in which the paper entirely wraps and seals tubular member 12. The inner box has a top section (the top surface defined by transparent paper 12) and a bottom section (the bottom surface defined by transparent paper 12). This combination clearly teaches a "rectangular cross section with opposed top and bottom sections" (Note: Figure 4). The Appellant further argues that the Examiner has asserted that tubular member is an inner box. The inner box is not defined only by the tubular member 12 but instead, the tubular member 12 and transparent sheet 11, as noted above. The Examiner contends that the device of McILHenney meets the claimed inner box.

In response to Appellant's second argument that the tubular member is not a box and fails to teach a flat base, sides and a lid, it is noted that the limitations on which the Appellant relies are not stated in the claim. As noted above, the inner box is defined by the combination of the tubular member 12 and transparent sheet 11.

In response to Appellant's third argument that McILHenney fails to teach "the inner box having a transparent wall through which said gift is visible". McILHenney teaches a transparent wall as defined by the top surface of transparent paper 11. The transparent sheet 11 allows one to view a gift, in this instance candy, in the inner box as clearly seen in Figure 6. Appellant further argues in par. 3 of page 9 through page 10, that the transparent sheet is not a transparent wall. Because the transparent paper covers the tubular member, does not prevent the transparent paper to act as a wall when covering or wrapped and sealed about the tubular member. Therefore, the Examiner contends that the transparent paper provides a transparent wall when wrapped and sealed about the tubular member.

In response to Appellant's fourth argument that the Declaration submitted provides a showing of commercial success, the Examiner contends that the Appellant has not established a nexus between the claimed invention and evidence of commercial success. First, the Appellant has not demonstrated that the sold approximately 10,000 gift display boxes was due to the claimed subject matter. Secondly, the Appellant stated that the 10,000 gift display boxes were sold by advertisement of a catalogue. However, this does not establish the evidence of commercial success. For example only, the order catalogue could have been sent to 1 million people and only 10,000 of

Art Unit: 3725

the people might have purchased the product from the catalogue. This advertisement of the product in the order catalogue does not provide enough evidence to establish commercial success. Finally, Appellant has failed to show evidence that the claimed product has outsold similar typed products in industry sales. In this instance, the Appellant has not provided any evidence by data collection that the product has outsold similar typed products in industry sales. For the reasons noted above, it is believed that the Appellant has not established a nexus between the claimed invention and evidence of commercial success.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Bena Miller

BENA MILLER
PRIMARY EXAMINER

Conferees:



Lowell Larson, Dmitry Suhol, Bena Miller